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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,767	02/07/2005	Peter Kastenmayer	112701-444	7519
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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER				
MEHTA, HONG T				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
07/10/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### Office Action Summary

**Application No.**

10/523,767

**Applicant(s)**

KASTENMAYER ET AL.

**Examiner**

HONG MEHTA

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 5, 12-25 and 28-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6-11, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicant's remarks filed on April 1, 2009. Amended claims 1, 3, 6-11, 26 and 27 are under examination.

#### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1, 3 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knights et al. (US 5,766,330).**

5. **Regarding claims 1 and 27**, Knights et al. disclose calcium absorption enhancer composition comprising an active ingredient calcium (col. 5, lines 47-50; col. 6, lines 54-57) and egg whites (col. 6, lines 8-14) as protein source. Knights et al. disclose a protein content of 25% and calcium content of 34%, (col. 9, lines 22-25, col. 5, Table 1, lines 5-13) with ratio of egg whites/calcium, 25 to 34.

6. Knights et al. and the claims differ in that Knights et al. does not disclose the exact same proportions as recited in the instant claims.

7. However, one of ordinary skill in the art at the time of the inventions was made would have considered the invitation to have been obvious because the compositional proportions taught by Knights et al. overlap the instantly claimed proportions and therefore are considered to establish a *prima facie* case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

8. "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is optimum combination of the percentages", *In re Peterson*, 65 USPQ2d 1379 (CAFC 2003).

9. **Regarding claim 3**, Knights et al. disclose the egg whites (col. 6, lines 8-14). Knights is silent on egg whites containing ovalbumin, ovotransferrin and ovomucoid, however it is inherent that ovalbumin, ovotransferrin and ovomucoid are naturally occurring proteins in egg whites.

**10. Claims 6-11, and 26 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable by Bergenfield et al. (US 6,221,418 B1).**

11. **Regarding claim 6**, Bergenfield et al. discloses baked products comprising a dietary supplement (col. 3, lines 23-30) consisting of egg whites (col. 4, lines 52-55) and calcium caseinate (col. 5, lines 1, 11, 20).

12. Bergenfield et al. discloses egg whites in amount by wt. of 28% to 32% and calcium caseinate in the amount by wt. of 39% to 42% (col. 5, lines 11-12).

13. Bergenfield et al. and the claims differ in that Bergenfield does not disclose the exact same proportions as recited in the instant claims.

14. However, one of ordinary skill in the art at the time of the inventions was made would have considered the invitation to have been obvious because the compositional proportions taught by Knights et al. overlap the instantly claimed proportions and therefore are considered to establish a *prima facie* case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

15. "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is optimum combination of the percentages", *In re Peterson*, 65 USPQ2d 1379 (CAFC 2003).

16. **Regarding claim 7 and 10**, Bergenfield discloses orally ingestible composition of a food product (col. 1, lines 9-13; col. 3, lines 25-28 and 60-63). Examiner considers food to be dietary and nutritional supplement to human and/or animal upon consumption

17. **Regarding claim 8 and 26**, Bergenfield teaches orally ingestible composition with proportion of egg white and calcium compared to total composition with calcium amount by wt. ranging 39% to 42% and egg whites in amount by wt. of 28% to 32% (col. 5, lines 11-12; claim 9, col. 8, lines 65-67 and col. 9, lines 1-9).).
18. **Regarding claim 9**, Bergenfield teaches orally ingestible composition with functional ingredients (col. 4, lines 45-52 and 62).
19. **Regarding claim 11**, Bergenfield teaches orally ingestible composition as active ingredients are in powder form (col. 4, lines 37-41, and 53-57).

***Response to Arguments***

20. Applicant's arguments with respect to claim April 1, 2009 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Knight et al. does not disclose egg whites as protein source to amended claim 1. Examiner disagrees. Knight et al. discloses eggs (col. 6, line 11) which include egg whites, and egg white (col. 6, line 14) as protein source with calcium.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG MEHTA whose telephone number is (571)270-7093. The examiner can normally be reached on Monday thru Thursday, from 7:30 am to 4:30 pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/JENNIFER MCNEIL/

Supervisory Patent Examiner, Art Unit 1794